



# UNITED STATES PATENT AND TRADEMARK OFFICE

nlw

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,551	03/21/2001	Tetsuo Nakata	826.1711/JDH	2646

21171 7590 03/16/2004

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
----------

GART, MATTHEW S

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/812,551

Applicant(s)

NAKATA ET AL.

Examiner

Matthew s Gart

Art Unit

3625

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

Claims 1-13 are pending in the instant application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Referring to claims 1-13. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable (i.e. A sales method for selling a literary work).

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs that impart functionality when employed as a computer component. “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Art Unit: 3625

Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Furthermore, since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material.

The Examiner notes, the independent claims of the instant invention were amended (Paper No. 3) in an attempt to make the claims statutory. The amendment (Paper No. 3) does not put the claimed invention in the technological arts. The claimed invention must utilize technology in a non-trivial manner. Providing information across a network is merely a physical transformation of data. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3625

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by**

**Cooper Patent Application Publication US 2001/0051996.**

Referring to claim 1. Cooper discloses a sales method for selling a literary work using a sale device, said sale device communicating with a purchase device via a network (paragraph 0006), comprising:

- Selling the literary work (paragraph 0006);
- Associating information about the literacy work and information about a purchaser that has purchased said literary work; and
- Providing said associating information via the network (paragraph 0163).

Referring to claim 2. Cooper further discloses a sales method wherein the literary work is sold per units of rights based on a copyright of the literary work (abstract and paragraph 0082).

Referring to claim 3. Cooper further discloses a sales method wherein the information about the purchaser is provided per units of the sold rights (paragraph 0093).

Referring to claim 4. Cooper further discloses a sales method comprising:

- Notifying a seller of the literary work of rights based on the copyright corresponding to a type of the literary work (paragraph 0093); and

Art Unit: 3625

- Obtaining from the seller information about the right to be sold, from the notified rights (paragraph 0093 and paragraph 0127).

Referring to claim 5. Cooper further discloses a sales method wherein the information about the purchaser is provided to an arbitrary person (Figure 2).

Referring to claim 6. Cooper further discloses a sales method wherein the information about the purchaser is provided after payment of a purchaser price is confirmed (paragraph 0220 to paragraph 0230).

Referring to claim 7. Cooper discloses a purchase method for purchasing a literary work using a purchase device, said purchaser device communicating with a sale device via a network, comprising:

- Purchasing the literary work (paragraph 0017); and
- Being authenticated to be a purchaser of the literary work by publicizing the fact via a network (paragraph 0017).

Referring to claim 8. Claim 8 is rejected under the same rationale as set forth above in claims 1-6.

Referring to claim 9. Claim 9 is rejected under the same rationale as set forth above in claims 1-6.

Referring to claim 10. Claim 10 is rejected under the same rationale as set forth above in claims 1-6.

Referring to claim 11. Claim 11 is rejected under the same rationale as set forth above in claims 1-6.

Art Unit: 3625

Referring to claim 12. Claim 12 is rejected under the same rationale as set forth above in claims 1-6.

Referring to claim 13. Claim 13 is rejected under the same rationale as set forth above in claims 1-6.

### ***Response to Arguments***

Applicant's arguments filed January 5, 2004 have been fully considered but they are not persuasive.

The Applicant Argues that Cooper's priority is flawed due to a filing date (February 20, 2001) that is more than a year from a provisional filing date (February 18, 2000).

The examiner notes, a provisional application will automatically be abandoned 12 months after its filing date and will not be subject to revival to restore it to pending status thereafter. See 35 U.S.C. 111(b)(5). Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day if the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. For example, if a provisional application was filed on January 15, 1999, the last day of pendency of the provisional application under 35 U.S.C. 111(b)(5) and 35 U.S.C. 119(e)(3) is extended to January 18, 2000 (January 15, 2000 is a Saturday and

Art Unit: 3625

Monday, January 17, 2000 is a Federal holiday and therefore, the next succeeding business day is Tuesday, January 18, 2000). A nonprovisional application claiming the benefit of the provisional application must be filed no later than January 18, 2000.

The Examiner notes, February 18, 2001 was a Sunday, February 19, 2001 was a Federal Holiday (MLK Day), the last day of pendency of the provisional application was extended to February 20, 2001. Cooper (non provisional application No. 09/789,298) correctly claims the benefit of provisional application No. 60/183638.

The Applicant argues that Cooper does not disclose associating information about the literacy work and information about a purchaser that has purchased said literary work.

The Examiner notes, the Abstract of Cooper discloses a method and system for transferring electronic media information over a public network in such a way as to provide safeguards for inappropriate distribution of copyright or otherwise protected materials are described. The media information is transparently watermarked with a unique ID, such as one generated from X.509 Digital Certificate and public-key cryptography public/private key pairs, such that the information can be identified as belonging to a particular individual. A system and method for monitoring the movement of such watermarked files, positively identifying people who have inappropriately distributed copyright materials over a public network without permission, and taking appropriate enforcement action against such people. Ultimately the goal of Cooper is to identify a purchaser.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

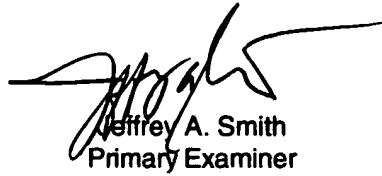
Application/Control Number: 09/812,551

Page 9

Art Unit: 3625

MSG

March 8, 2004



Jeffrey A. Smith  
Primary Examiner